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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,873	07/14/2003	Hwan Koo Lee	1293.1814	3436

21171 7590 10/26/2005

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EXAMINER	
RODEE, CHRISTOPHER D	

ART UNIT	PAPER NUMBER
1756	

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/617,873	**Applicant(s)** LEE ET AL.	
	Examiner Christopher RoDee	**Art Unit** 1756	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires *4* months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-8,10-13 and 15-20*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 8/26/05
13. ☐ Other: _____.

CHRISTOPHER RODEE
PRIMARY EXAMINER

Continuation of 3. NOTE: the proposed amendment requires further search and consideration because the claims now include a limitation on the use of the photoreceptor. Specifically, the claims now specify that the photoreceptor supresses a decrease in charged electrical potential and dark decay upon repeated use. This limitation is indefinite because it is unclear how the photoreceptor is used. The proposed use appears to further limit the photoreceptor, although the limitation is unclear. This is not the same limitation as previously presented in claims 8 and 13. Proposed claims 3 and 10 also require further consideration because the formula (5) would be canceled if the amendment were entered. There is no convincging showing under Rule 116 why this amendment is proper now and could not have been previously presented, particularly when the grounds of rejection are the same at Final as in the first Office action.

Continuation of 11. does NOT place the application in condition for allowance because: the remarks are diretced to the unentered amendment. Further the proposed amendment appears to further limit the biphenyl fluorenone groups to those of the formula (1). These are the same biphenyl fluorenone groups as are presented in the applied art. This proposed limitation does not appear to define over the art even if it were entered. The Examiner notes that Formula (5) from the dependent claims is proposed to be canceled by the amendment. However, this does not change the fact that this formula is included within the scope of independent claims polyester. The Examiner again must emphasize that the polyesters of the claims must contain additional groups to those shown by the formula (1) to be a polyester resin. The JP reference is still seen as anticipating the claims and rendering the claims obvious in view of Diamond. With respect to the 103 rejection of Katsukawa in view of Kanamura, appicant's remarks on page 24 of the response are not understood. Applciants state " Kanamuru cannot be relied on to cure the deficiencies of Katsukawa because the present invention is limited to esters." A review of the rejection shows, Katsukawa is relied upon for teaching the claimed polyester in a photoreceptor while Kanamura is relied upon for the disclosure of useful antioxidant materials. The reference to pyrroles is also not understood because the supporting reference is relied upon for its disclosure of antioxidants, not the claimed polyester. Clarification is requested should this line of traversal be maintained. The remaining rejection under 103 considering Yokota is maintained at least because the amendment has not been entered. The reference to section 103c is noted but is not persuasive because the statement does not show coownership at the time of the instant invention. The obviousness type double patenting rejection is also maintained because the supporting reference teaches the claimed antioxidants and the combination rejection is proper for the reasons of record.